Remarks

I. STATUS OF THE CLAIMS

Claims 14, 16-19, 22, 25-27, and 29-32 are currently pending in the subject patent application. By the present amendment, claims 11-13, 15, 20, 21, 23, 24, 28 and 33-69 have been cancelled without prejudice, and claims 14, 16-19, 22, 25, 27 and 29-32 have been amended. It is submitted that no new matter has been added to the subject application.

With specific regards to the aforementioned claim amendments:

- Claim 14 has been amended to independent form and incorporates the recitations of now cancelled claims 11 and 12;
- Claim 22 has been amended to independent form and incorporates the recitations of now cancelled claims 20 and 21; and
- Claim 26 has been amended to independent form and incorporates the recitations of now cancelled claims 23 and 24.

II. 35 USC §112 CLAIM REJECTIONS

Claims 42, 44 and 45 stand rejected under 35 USC §112, second paragraph. As mentioned above, claims 42, 44 and 45 each have been canceled without prejudice, thus this rejection is now moot.

III. DOUBLE PATENTING CLAIM REJECTIONS

Claims 20 and 21 were rejected based upon a statutory double patenting rejection in view of co-pending Application No. 09/751,490. Since each of these claims have been canceled without prejudice, this rejection is now moot.

Claim 22 stands rejected based upon a non-statutory double patenting rejection in view of co-pending Application No. 09/751,490. To overcome this rejection, a Terminal Disclaimer under 37 CFR §1.321 is filed herewith for claim 22 in view of co-pending

Application No. 09/751,490. Accordingly, the subject non-statutory double patenting rejection has each been overcome and withdrawal thereof is warranted.

IV. 35 USC § 102 AND 103 CLAIM REJECTIONS

In the June 4, 2004 Office Action, the claims were rejected as follows:

A. Claims 33-36, 38-48, 50-55 and 57-69 were rejected under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,654,779 to Tsuei (the Tsuei patent);

B. Claims 11-14, 16-27 and 29-32 stand rejected under 35 USC §103 as being obvious in view of the Tsuei patent in further view of U.S. Patent No. 6,427,164 to Reilly (the Reilly patent); and

C. Claims 15 and 28 were rejected under 35 USC §103 as being obvious in view of the Tsuei and Reilly patents in further view of U.S. Patent No. 6,654,789 to Bliss et al.

With respect to above mentioned rejections (A) and (C), since each of the claims forming the basis of these rejections have been canceled without prejudice (namely, 15, 28, 33-36, 38-48, 50-55 and 57-69), these rejections are now moot and withdrawal thereof is warranted.

Regarding the remaining rejection (B) and with regards to claims 11-13, 20, 21, 23, and 24, since each of these claims have been canceled without prejudice, the subject rejection for these claims is now moot and withdrawal thereof is warranted.

Concerning the remaining claims under rejection (B) (namely, 14, 16-19, 22, 25, 27 and 29-32), Applicant would first like to reiterate that each of independent claims 14, 22 and 25 relate generally to a method for retrieving a preferred e-mail address that is associated with a non-preferred e-mail address. However, if a preferred e-mail address has not been previously registered for an aforementioned non-preferred e-mail address, the present claimed invention may nevertheless still provide aid to a user seeking a preferred e-mail address by providing a "closet match" e-mail address to a user based upon the non-

preferred e-mail address the user was querying from. Specifically, and with reference to claim 14[1], what is recited is:

> if no [an match cannot be found between a preferred e-mail address and a non-preferred e-mail address], parsing the non-preferred e-mail address to extract the domain name and determining if the domain name has been registered with the second address;
> determining if a list of usernames for the parsed domain name has been registered with the second address; and
> sending the closest match username to the sender address if it is determined that there is a closest match.

In other words, even if an exact match is not found for a non-preferred e-mail address, the method of the present invention may still provide a "closet match" preferred e-mail address to a user "if a list of usernames for the parsed domain name has been registered with the second address [e.g., the e-mail forwarding service]". It is respectfully submitted that for at least the reasons set forth below, neither the Tsuei nor Reilly patent teach or suggest this feature.

With regards to the Tusei patent, the examiner stated: "Tsuei discloses the method as recited in claim 13 further including the step of sending the closet match username to the sender address if it is determined that there is a closet match (see, col. 9, lines 59-64)." Applicant respectfully traverses this alleged disclosure of the Tsuei patent.

The Tsuei patent teaches an email forwarding system that is operative to receive an undeliverable e-mail message and determine whether it has a forwarding e-mail address for the aforesaid undeliverable e-mail message. See for example, col. 7, lines 9-24 of the Tsuei patent. And if it does not have a forwarding e-mail address prescribed in its database, it indicates "this fact" to the user and thus provides no further assistance to the user in forwarding the undeliverable e-mail message. See for example, col. 7, lines 24-27 of the Tsuei patent. What is explicitly taught in col. 9, lines 59-64 of the Tsuei patent is:

> After the EAMS 330 receives the address query, step 450 is performed. In step 450, the EAMS 330 searches its database, i.e. database 338 FIG. 3, to see if it contains a record relating a new address to the address contained in the address query. If a

[1] It is submitted independent claims 22 and 25 contain similar recitations.

> new address is found for the address of the address query, then there is an EAMS match.
>
> *If there is no EAMS match, control passes to step 455.*
>
> (*Italics* added).

And pursuant to step 455, "the EAMS 330 notifies the sender ISP that there was no EAMS match." See, col. 10, lines 4-6 of the Tsuei patent.

In other words, if there is not an exact match between non-preferred and preferred e-mail usernames in the EAMS (E-mail Address Management System) of the Tsuei patent, the EAMS notifies this occurrence to a user and in contrast to the present claimed invention provides no further aid in providing a preferred e-mail address to a user. The Tsuei patent simply does not teach nor suggest "sending the closest match username to the sender address if it is determined that there is a closest match." In contrast, when the EAMS of the Tsuei patent determines there is no exact match it explicitly teaches that it only "notifies the sender ISP that there was no EAMS match" and provides no teachings or suggestions whatsoever concerning determining a "closet match."

With regards to the Reilly patent, like the Tsuei patent, it teaches an email forwarding system in which a user requesting assistance will only be given e-mail forwarding assistance if, and only if, an exact match is found between a registered old e-mail address and a new address. For instance, col. 8, lines 23-30 and col. 9, lines 4-6 of the Reilly patent explicitly states:

> Forwarding service 300 receives the request, which preferably includes the old e-mail address, and checks its database for any new address associated with the old e-mail address . . .[and] . . .If no new address is found, forwarding server 300 returns a message to receiving e-mail server 240 indicating this fact.

Thus, the Reilly patent, and just like the Tsuei patent, explicitly teaches that if there is not an exact match between non-preferred and preferred e-mail usernames, this "fact" is indicated to a user seeking such assistance, and in contrast to the present claimed invention, provides no further aid in providing a preferred e-mail address to a user.

In conclusion, neither the Tsuei nor Reilly patent, taken either separately or together, teach nor suggest "sending the closest match username to the sender address if it is

determined that there is a closest match." In contrast, both aforesaid patents actually teach away from this by explicitly teaching that when an exact match is not found the process for seeking a preferred e-mail address must end with the user only be given notification that a preferred e-mail address cannot be found.

Accordingly, for at least the above-explained reasons, it is respectfully submitted neither the Tsuei patent nor the Reilly patent, taken either alone or in combination with one another, teach Applicants invention as presently claimed in independent claims 14, 22 and 25 along with their respective depending claims 16-19, 26, 27, 29-32. Therefore, it is submitted that claims 14, 16-19, 22, 25-27 and 29-32 patentably distinguish from the combination of the Tsuei and Reilly patents and removal of the subject 35 USC §103 rejection is warranted.

V. CONCLUSION

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims of this application (namely, 14, 16-19, 22, 25-27 and 29-32) are in condition for allowance and favorable action thereon is requested. If the Examiner should have any questions, he is urged to contact the undersigned attorney.

Respectfully submitted,

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